

Appl. 10/601,828
Reply to Office Action of January 19, 2007
Response Dated April 19, 2007

REMARKS

The Office Action mailed January 19, 2007 has been received and reviewed. Claims 1, 17-19 and 33-53 are currently pending in the application. Claims 1, 17-19, 36, 40 and 43-50 stand rejected. Claim 50 is canceled herein. Applicant notes that the Office Action does not indicate whether claims were withdrawn from consideration. It is noted that claims 33-35, 37-39, 41, 42 and 51-53 were earlier withdrawn from consideration. Applicant respectfully requests reconsideration of the application in view of the present amendments and remarks.

Claim Objections

Claim 50 was objected to in the Office Action as assertedly being redundant with claim 47, from which it depends. Claim 50 is canceled herein, rendering this rejection moot.

35 U.S.C. § 102(b) Rejections

Claims 1, 18, 19, 40, 45-47 and 49 were rejected in the Office Action as assertedly anticipated by U.S. Patent No. 3,863,550 to Sarka et al. ("Sarka") under 35 U.S.C. § 102(b). As previously indicated by the applicant, anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference or embodied in a single prior art device or practice. *Minnesota Min. & Mfg. C. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). Each of pending

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independent claims 1, 40 and 47, includes the elements of "a layer of adhesive interposed between said back surface of said at least one metal base portion and said" covering or housing. This element is not disclosed in Sarka, Sarka does not anticipate the claimed invention and this rejection should be withdrawn. Additionally, applicant reiterates its prior arguments that Sarka does not disclose a covering or housing as recited in the claims.

35 U.S.C. § 103(a) Rejections

Claims 1, 18, 19, 40, 45-47 and 49 were rejected in the Office Action as assertedly obvious over Sarka in view of U.S. Patent 6,543,131 to Beroz et al. ("Beroz") under 35

U.S.C. § 103(a). The Office Action states that

it would have been obvious to one having ordinary skill in the art to use adhesive (e.g., two-sided adhesive tape or a mass of adhesive material) to affix the assembly, particularly plate 2, in the fixture to facilitate assembly of the die disclosed in Sarka. One having ordinary skill in the art would be very familiar with the use of such adhesive in the assembly arts and know that it is often applied to assist in assembling of components; for example, such adhesive would be applied between the bottom plate 2 and the bottom 21 of the molding fixture to maintain the respective positions of the die components and the molding fixture during assembly, whereby after assembly, the die would be removed from the molding fixture and the adhesive removed. Beroz discloses one example of the use of such an adhesive to temporarily hold components in place during assembly (e.g., see Figs. 9, 10 and col. 7, lines 23-27; col. 15, lines 26-33). Therefore, it would have been obvious to one having ordinary skill in the art to attach the covering to the metal base portion in Sarka for at least the benefits described above.

As set forth in MPEP §2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed

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invention. *Bausch & Lomb v Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416 (Fed. Cir. 1986). Further, “[i]t is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). MPEP § 2145. Additionally, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).”

At column 3, lines 49-55, Sarka describes the preparation of the plates 1 and 2, prior to their assembly in the molding fixture, adjacent to bottom 21. Sarka states that:

After etching of the metal plates has been effected, the remaining resist layer is removed (FIG. 7) and after chemically etching the plates, both the top face of the upper plate and the bottom face of the lower plate are coated with a mold release film 14 (FIG. 8). Any conventional mold release film may be used.

Accordingly, Sarka teaches placing a mold release on the bottom surface of the plate 2 before placement in the molding fixture, in order to facilitate removal therefrom. By explicitly using a mold release to prevent adherence to the molding fixture Sarka teaches away from the temporary use of an adhesive “applied between the bottom plate 2 and the bottom 21 of the molding fixture to maintain the respective positions of the die components and the

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molding fixture during assembly” as suggested in the Office Action. Additionally, applicant submits that use of an adhesive in such a manner with the plates and molding fixture of Sarka would both render it unsatisfactory for its intended purpose and change its principle of operation by causing it to adhere to the molding fixture rather than facilitate its release therefrom. Applicant thus submits rejection should be withdrawn and the claims allowed.

Claims 17, 43, 44 and 48 were rejected in the Office Action as assertedly obvious over Sarka in view of Beroz under 35 U.S.C. § 103(a). As stated previously herein, independent claims 1, 40 and 47 contain elements not disclosed in Sarka, and combining the teachings of Beroz with the teachings of Sarka to include such elements not only goes against the explicit teachings of Sarka, but would render Sarka unsatisfactory for its intended purpose and change its principle of operation. Since each of dependent claims 17, 43, 44 and 48 depends from these independent claims, applicant submits that such claims are similarly allowable.

Claims 32 and 50 were rejected in the Office Action as assertedly obvious over Sarka in view of Beroz under 35 U.S.C. § 103(a). Claim 50 has been canceled herein rendering this rejection moot. Claim 32 was earlier canceled, rendering this rejection moot.

Claim 36 was rejected in the Office Action as assertedly obvious over Sarka in view of U.S. Patent 6,658,978 to Johnson (“Johnson”) under 35 U.S.C. § 103(a). The Action states that “Sarka discloses an apparatus (e.g., in Fig. 11) with almost every structural limitation of the claimed invention but lacks the at least one metal base portion and the blade being

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welded together" (Office Action at page 6). Claim 36 depends from independent claim 1.

As discussed previously herein, claim 1 includes elements that are not taught or suggested in Sarka and is allowable thereover. Applicant respectfully submits that claim 36 is allowable as depending from allowable claim 1 and this rejection should be withdrawn.

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CONCLUSION

The Examiner is welcome to call the attorney of record, Frank W. Compagni, at (801) 478-0071 if further discussion of this matter is warranted. Any fees due hereunder may be charged to Deposit Account No. 50-0881.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Frank W. Compagni', written over the printed name.

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